

Applicant : Randy G. Cooper et al.  
Serial No. : 10/730,637  
Filed : December 8, 2003  
Page : 8 of 12

Attorney Docket No. P-JK-01470

### **REMARKS**

Claims 1-9, 11, 13-14, 16-34, 68-69, 71, and 75-76 are pending, with claims 1 and 19 being independent. Claims 1, 19, 20-22, 25, and 32-34 have been amended and claims 10, 12, 15, 35-67, 70, and 72-74 have been cancelled. Applicants respectfully request reconsideration in light of these amendments and the following remarks.

### **Examiner Interview**

Applicants thank the Examiner for the courtesy of an Interview with Applicants' attorney on April 4, 2006. The Examiner and Applicants attorney discussed Hestily and the present amendment to claim 1. No agreement was reached. The Examiner reserved the right to perform a further search and to further consider the amendment.

### **Election/Restriction**

The Office Action has withdrawn from consideration claims 36, 41-44, 52, and 72-74 as being drawn to a kit and a knob shaped handle that are separable and distinct from the other previously presented claims. To expedite prosecution Applicants have cancelled these claims, without prejudice to presentation in this or a subsequent application. In addition, Applicants respectfully traverse the statement in the Office Action that "there is no support in the originally filed disclosure for a 'kit'" (Office Action at page 2).

### **Specification**

The amendment filed on November 21, 2005 has been objected to under 35 U.S.C. § 132(a) as introducing new matter. In particular, the Office Action asserts that the original disclosure does not support "the grasping member and the connecting member are at an angle of greater than 90 degrees to one another," as recited in claim 70, and "the grasping member and the connecting member are at an angle of greater than 90 degrees to one another," as recited in claim 71. To expedite prosecution, Applicants have cancelled claim 70. With respect to claim 71, Applicants respectfully submit that the claimed features are supported by the original disclosure, e.g., at ¶ 0024 and FIG. 4. Therefore, Applicants respectfully request withdrawal of this rejection.

Applicant : Randy G. Cooper et al.  
Serial No. : 10/730,637  
Filed : December 8, 2003  
Page : 9 of 12

Attorney Docket No. P-JK-01470

### **Information Disclosure Statement**

As noted in the Amendment filed November 21, 2005, the IDS filed January 20, 2004 inadvertently lists the U.S. Patent to Imihashi as U.S. Pat. No. 4,983,642, rather than U.S. Pat. No. 4,938,642. Applicants respectfully note that the correct U.S. Patent to Imihashi has been listed on a Form PTO-892 attached to this Office Action, indicating its consideration by the Examiner.

### **35 U.S.C. § 112 Rejections**

Claims 70 and 71 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. To expedite prosecution, Applicants have cancelled claim 70. With respect to claim 71, the Office Action asserts that there is no support in the specification for "the grasping member and the connecting member are at an angle of greater than 90 degrees to one another." Applicants respectfully submit that the claimed features are supported by the original disclosure, e.g., at 0024 and FIG. 4. Accordingly, Applicants request withdrawal of this rejection. Applicants also note that claim 70 is not limited to a relative angle of 70 degrees or 45 degrees, as set forth on page 4 of the Office Action.

Claims 25, 33, and 34 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants respectfully submit that the amendments to claims 25 and 33 obviate these rejections. Accordingly, Applicants request withdrawal of these rejections.

### **35 U.S.C. § 102(b) Rejections**

Independent claim 1, and its dependent claims 3, 7, 10, 16-18, 68, 69, 75, and 76, have been rejected under 35 U.S.C. § 102(b) as being anticipated by Hestily (U.S. Pat. No. 4,051,880). Of these, claim 10 has been cancelled, without prejudice. For at least the following reasons, Applicants respectfully request withdrawal of this rejection as applied to the remaining claims.

With respect to claim 1, Hestily does not describe or suggest at least the claimed "handle [that] defines a channel therethrough with a terminal portion adapted to be attached to a vacuum source that is external to the power tool" (emphasis added). Rather, in Hestily, the handle 30 defines a dust passage 74 (which the Examiner equates to the

Applicant : Randy G. Cooper et al.  
Serial No. : 10/730,637  
Filed : December 8, 2003  
Page : 10 of 12

Attorney Docket No. P-JK-01470

claimed channel) attached to a blower 82 (which the Examiner equates to the claimed vacuum source) that is part of the router 10 (which the Examiner equates to the claimed power tool). In reply to the Response to Arguments on page 12 of the Office Action, claim 1 has been amended to positively set forth that the vacuum source is external to the power tool, in contrast to Hestily. For at least these reasons, claim 1, and its dependent claims 3, 7, 16-18, 68, 69, 75, and 76, are not anticipated by Hestily.

### **35 U.S.C. § 103(a) Rejections**

#### **Claims That Depend From Independent Claim 1**

Claims 2, 4-6, 8, 9, 11, 13, and 14, which depend directly or indirectly from independent claim 1, have been rejected under 35 U.S.C. § 103(a) over Hestily in view of one of Vess (U.S. Pat. No. 4,102,370), Yano (U.S. Pat. No. 5,640,741), Lui (U.S. Pat. No. 6,506,006), and Williams (U.S. Pat. No. 6,266,850). None of these references, alone or in combination, remedy the deficiencies of Hestily discussed above with respect to independent claim 1.

In particular, Vess relates to a spring biased spacing attachment for a router that allows a user to vary the depth of cut of the router, Yano relates to a soft grip to cover a portion of a handle of a power tool, Lui relates to a power hand tool having a detachable D-shaped handle, and Williams relates to a hand-tool having adjustable handles. Vess, Yano, Lui, and Williams, alone or in combination, fail to describe or suggest at least a "handle [that] defines a channel therethrough with a terminal portion adapted to be attached to a vacuum source that is external to the power tool," as recited in claim 1. For at least these reasons, dependent claims 2, 4-6, 8, 9, 11, 13, and 14 are patentable over Hestily, Vess, Yano, Lui, and Williams, or any combination thereof.

#### **Independent Claim 19 And Its Dependent Claims**

Independent claim 19, and its dependent claims 20-26, 28, and 32-34, have been rejected under 35 U.S.C. § 103(a) as being obvious over Hestily in view of Kopras (U.S. Pat. No. 6,443,675) or in view of Yano. Claims 29, 30, and 31, which depend directly or indirectly from claim 19, have been rejected under 35 U.S.C. § 103(a) as being obvious over Hestily in view of Kopras and one of Lui, Williams, or Turnbull (U.S. Pat. No.

Applicant : Randy G. Cooper et al. Attorney Docket No. P-JK-01470  
Serial No. : 10/730,637  
Filed : December 8, 2003  
Page : 11 of 12

2,630,152). As explained below, Hestily, Kopras, Yano, Lui, Williams, and Turnbull, alone or in combination, fail to describe or suggest at least a “grip coupled to the grasping member and having a plurality of protrusions directed inwardly toward the motor housing,” as recited in claim 19 (emphasis added).

Hestily fails to describe or suggest a “grip” coupled to the handle 30 (as acknowledged on page 9 of the Office Action), let alone a grip that includes “a plurality of protrusions directed inwardly toward the motor housing,” as recited in claim 19.

Kopras describes a hand-held power tool 20 with a motor housing 22 and a detachable handle 24 that includes a gripping surface 70. Kopras does not describe or suggest that the gripping surface 70 includes “a plurality of protrusions directed inwardly toward the motor housing,” as recited in claim 19.

Yano describes a power tool having a main body M and a handle portion 4 that includes a soft grip 1, which extends from the upper top of the rear end of the main body M to the bottom of the handle portion 4. Yano does not describe or suggest that the soft grip 1 includes “a plurality of protrusions directed inwardly toward the motor housing,” as recited in claim 19. With respect to the Response to Arguments on page 12 of the Office Action, while Applicants disagree with the Examiner’s characterizations of Yano, to expedite prosecution, claim 19 has been amended to positively recite “a plurality of protrusions directed inwardly toward the motor housing,” which Yano fails to describe or suggest.

Lui describes a hand-held electric trimmer 10 with a body 100 that contains a motor M and a detachable handle 200. Lui does not describe or suggest that the handle 200 includes “a plurality of protrusions directed inwardly toward the motor housing,” as recited in claim 19.

Williams describes a waxer-buffer 10 including a housing 22 that contains a motor, and an adjustable handle 20 attached to the housing 22. Williams does not describe or suggest that the handle 20 includes “a plurality of protrusions directed inwardly toward the motor housing,” as recited in claim 19.

Turnbull relates to a router having a motor casing 10 supported on a pair of rockers 28, and a handle 20 attached to the motor casing 10. Turnbull does not describe

Applicant : Randy G. Cooper et al.  
Serial No. : 10/730,637  
Filed : December 8, 2003  
Page : 12 of 12

Attorney Docket No. P-JK-01470

or suggest that the handle 20 includes "a plurality of protrusions directed inwardly toward the motor housing," as recited in claim 19.

For at least the foregoing reasons, claim 19, and its dependent claims 20-26 and 28-34, are patentable over Hestily, Kopras, Yano, Lui, Williams, and Turnbull, or any combination thereof. Accordingly, Applicants respectfully request withdrawal of these rejections.

#### Conclusion

Applicants do not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, Applicants have not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application.

We do not believe that any fee is due at this time, however, if there is please charge to our deposit account 02-2548.

Respectfully submitted,

Date: April 27, 2006



Scott B. Markow  
Reg. No. 46,899

The Black & Decker Corporation  
701 E. Joppa Road - TW199  
Towson, MD 21286  
Facsimile: (410) 716-2610  
Telephone: (410) 716-3606